THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LOUIS RENBAUM, MARK S. SOLOMON
and WILLIAM D. TIPPINS

Appeal No. 96-2425
Application 08/094,933[1]

ON BRIEF

Before KIMLIN, ELLIS and OWENS, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-9, which are all of the claims remaining in the application.

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[1] Application for patent filed July 21, 1993.

THE INVENTION

Appellants' claimed invention is directed toward a process for preparing a reaction product containing methylene diphenylamine. Appellants react aniline and formaldehyde in the presence of an acid catalyst, and reduce the acid level of the reaction mixture during digestion of the reaction mixture.[2] Appellants also claim the product made by the process. Claims 1 and 9 are illustrative and read as follows:

1. A process for preparing a reaction product containing methylene diphenylamine, comprising reacting aniline and formaldehyde in the presence of catalyst;

reducing the acid level of the resulting reaction mixture during digestion of the reaction mixture, and followed by completely neutralizing the reaction product after digestion.

9. A reaction product comprising methylene diphenylamine which is prepared by the process of claim 1.

THE REFERENCE

Bolton et al. (Bolton)	5,286,760	Feb. 15, 1994 (filed Oct. 9,

[2] Appellants state that "[b]y the term 'digestion' is meant the stage at which the intermediate aminobenzylamines rearrange to form methylene diphenylamines and polymethylene polyphenylamine" (specification, page 4, lines 19-22).

1992)

THE REJECTIONS

The claims stand rejected as follows: claims 1-9 under the judicially created doctrine of obviousness-type double patenting over claims 1-9 of Bolton; claims 1-9 under 35 U.S.C. § 103 over Bolton; and claim 9 under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Bolton.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with the examiner that the reaction product recited in appellants' claim 9 is anticipated by and obvious over Bolton, and obvious over Bolton's claim 9. Accordingly, we sustain all of the aforementioned rejections of claim 9. We agree with appellants, however, that the rejections of claims 1-8 are not well founded. We therefore do not sustain these rejections.

Rejections of claim 9

Bolton discloses a process wherein a reaction product containing methylene diphenylamine is prepared by reacting aniline and formaldehyde in the presence of an acid catalyst (col. 2, lines 6-9). The acid is partially neutralized at the condensation stage, which is the stage at which the aniline and formaldehyde react in the presence of the acid (col. 2, lines 13-15, 38-43 and 66). This stage takes place before the digestion stage, which is the stage at which the intermediate aminobenzylamines rearrange to form the reaction product containing methylene diphenylamine and polymethylene polyphenyl (col. 2, lines 44-50 and 66-68). Thus, Bolton's process differs from that of appellants in that Bolton's partial neutralization takes place during the condensation stage whereas appellants' partial neutralization takes place during the digestion stage.

Appellants argue that because they partially neutralize their catalyst during the digestion stage rather than the condensation stage, the rearrangement of the intermediates of methylene diphenylamine does not proceed in the same manner as in Bolton's process and that, therefore, appellants' product is not the same as that of Bolton (brief, pages 7-8).

Appellants argue that Bolton's removal of catalyst prior to digestion reduces the potential for rearrangement of the condensation reaction mixture to form unwanted compounds, and that Bolton teaches that reducing the acid level during the condensation stage has a significant effect on the level of impurities in the product (brief, page 7).

Appellants, however, state that even though appellants do not perform Bolton's condensation stage partial neutralization, to which Bolton attributes the low level of impurities of his product, appellants' product has impurity levels which are comparable to those of Bolton's product (brief, pages 4, 6 and 8). Thus, appellants acknowledge that their product is substantially the same as that of Bolton.

The patentability of a product made by a recited process, as in appellants' claim 9, is determined based on the product itself, not on the method of making it. *See In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) ("If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior art product was made by a different process.”). Whether a rejection is under 35 U.S.C. § 102 or § 103, when appellants’ product and that of the prior art appear to be identical or substantially identical, the burden shifts to appellants to provide evidence that the prior art product does not necessarily or inherently possess the relied-upon characteristics of appellants’ claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); *In re Fessmann*, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). The reason is that the Patent and Trademark Office is not able to manufacture and compare products. *See Best*, 562 F.2d at 1255, 195 USPQ at 434; *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Because, as acknowledged by appellants, Bolton’s disclosed and claimed (claim 9) product is substantially the same as that of appellants, and because appellants have not carried their burden of providing evidence which establishes that their claimed product is patentable over that of Bolton, we affirm the obviousness-type double patenting rejection of

appellants' claim 9 and the rejection of that claim under 35 U.S.C. § 102(e) as being anticipated by Bolton. Because anticipation is the epitome of obviousness, *see In re Skoner,* 517 F.2d 947, 950, 186 USPQ 80, 83 (CCPA 1975); *In re Pearson*, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974), we affirm the rejection of appellants' claim 9 under 35 U.S.C. § 103 over Bolton.

Rejections of claims 1-8

The examiner argues that appellants' partial neutralization during digestion encompasses partial neutralization at the very beginning of digestion which, the examiner states, "is obviously the same as Bolton" (answer, page 4). This argument is not consistent with Bolton's disclosure. Bolton states that "[i]t is a distinct feature of the invention that the acid level of the reaction mixture is maintained at a low level at the end of the condensation stage" (col. 3, lines 27-29) and that "[i]t is a distinct feature of the invention that the acid level is reduced before the reaction mixture is digested" (col. 3, lines 58-60). These excerpts clearly indicate that Bolton's partial

neutralization takes place before, not during, the digestion stage. As pointed out by appellants (reply brief, page 3), "before" is not "during", and the examiner has not explained why one of ordinary skill in the art would have modified Bolton's process such that the partial neutralization takes place during the digestion stage.

Accordingly, we conclude that the examiner has not carried his burden of establishing a *prima facie* case of obviousness of the process recited in any of appellants' claims 1-8. Hence, we do not sustain the rejection of these claims under 35 U.S.C. § 103. Similarly, because examiner has not explained why the partial neutralization recited in Bolton's claims at the condensation stage would have fairly suggested, to one of ordinary skill in the art, partial neutralization during the

digestion stage, we do not sustain the obviousness-type double patenting rejection of appellants' claims 1-8.

DECISION

The rejections of claims 1-8 under the judicially created

doctrine of obviousness-type double patenting over claims 1-9 of Bolton and under 35 U.S.C. § 103 over Bolton are reversed. The rejections of claim 9 under the judicially created doctrine of obviousness-type double patenting, under 35 U.S.C. § 102(e) as anticipated by Bolton, and under 35 U.S.C. § 103 as obvious over Bolton, are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

EDWARD C. KIMLIN Administrative Patent Judge	)	
JOAN ELLIS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)	

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